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Atty Dkt. No.: 10990640-2
USPN: 10/059,957

REMARKS

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-17.

Claim 1 has been amended to specify that the apparatus includes a purge station. Support for this amendment can be found in the specification, e.g., page 10, lines 12-24 and Figs. 4 and 6. Claim 1 as amended also specifies that the jet can dispense drops of at least one of a biomonomer and a biopolymer. Support for this amendment can be found in the specification, e.g., page 4, lines 6-9. Claim 1 has also been amended to cancel reference to a pressure source and a processor, which pressure source and processor are specified in new Claims 16 and 17, respectively.

Claim 4 has been amended to specify that the fluid is loaded through an exit end of an orifice. Support for this amendment can be found in the specification, e.g., at page 13, line 4.

Claim 10 has been amended to correct a minor typographical error.

As no new matter has been added by the above amendments, the Applicants respectfully request the entry thereof.

PRIORITY

The status of the parent application has been updated to cite the parent application's U.S. patent number.

SPECIFICATION

The Office Action indicates that the application contains references to other US applications or attorney docket numbers. These references have been amended to cite US patent numbers and publication numbers where appropriate.

DOUBLE PATENTING

Claim 1-15 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,323,043. In response thereto, a Terminal Disclaimer is being submitted herewith. As such, the Applicants respectfully request that this rejection be withdrawn.

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REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-3 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that Claims 1-3 are indefinite because an essential element, i.e., the biopolymers within the dispensing fluid, is missing from the claims. Independent Claim 1, and Claims 2 and 3 by virtue of their dependency therefrom, have been amended to specify droplets of at least one of a biomonomer and a biopolymer. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 102(c)

Claims 4-9 have been rejected under 35 U.S.C. § 102(c) as being anticipated by Barth et al. (US 6,461,812).

Under current case law, a reference does not anticipate a claim unless "all of the elements and limitations of the claim are found within [that]...reference...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of invention." *Scripps Clinic v. Genentech, Inc.*, 18 USPQ2d 1671, 1672 (Fed. Cir. 1992).

Independent Claim 4, and the claims that have depend therefrom, specify a method that includes (1) loading fluid through an exit end of an orifice into a reservoir in communication with the reservoir, and (2) loading the fluid which has entered the reservoir through the orifice into other delivery chambers communicating with the same reservoir.

The Applicants respectfully submit that Barth et al. do not teach a method as claimed in Claims 4-9. More specifically, Barth et al. do not teach a method that includes loading a fluid through an exit end of an orifice into a reservoir and loading other delivery chambers communicating with the same reservoir with the fluid. For example, the Examiner points to the abstract to support this rejection. However, the abstract merely teaches that; "In some embodiments the chamber and reservoirs are loaded with fluids...by drawing the selected fluids into the chambers through the orifices; or in other embodiments the fluids are introduced into the reservoirs." The abstract does not teach (1) loading fluid through an exit end of an orifice into a reservoir in communication with the reservoir, and (2) loading the fluid which has entered the reservoir through the orifice into other delivery chambers communicating with the same reservoir, as claimed in the subject claims.

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The Examiner further points to the passage at col. 6, line 27. However, this passage also fails to teach the method as claimed in the subject claims as it merely teaches that the device of Barth et al. may be positioned with the front surface of the orifice member facing a receiving surface and pressure may be increased or decreased over a meniscus of the fluid which can result in creating or changing a pressure differential in the fluid column.

Lastly, the Examiner points to the passage at col. 9, lines 40-52 as support for this rejection. However, this passage also fails to teach the method as claimed in the subject claims. Specifically, this passage refers to Figs. 3A-3C which illustrate an apparatus having a single reservoir (e.g., reservoirs 58 and 59) associated with a single delivery chamber (57 and 63, respectively) and a single orifice (54 and 55, respectively). In other words, a reservoir of this embodiment is only in communication with one delivery chamber and one orifice and thus it would not be possible to load a fluid into a reservoir through one of the orifices and load the fluid now contained in that reservoir into any other delivery chamber because, as shown in the figures, each reservoir is in communication with only one delivery chamber and one orifice and thus no other delivery chambers are in communication with the reservoir.

Accordingly, for at least the reasons described above, Barth et al. do not anticipate the subject claims. As such, the Applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §103

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayes et al. (US 5,658,802) in view of Burke et al. (US 5,300,958).

The M.P.E.P. provides clear guidance on the requirements of a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

M.P.E.P. § 2142. (Emphasis added.)

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Thus, the cited reference must teach or suggest all of the limitations of the claimed invention for the claimed invention to be rendered obvious over the reference. As described above, Claim 1 specifies an apparatus that includes a purge station. However, neither of the cited references teaches nor suggests a purge station.

Hayes et al. teaches an apparatus 10 for making arrays that generally includes (1) a set of fluid dispenser assemblies 20a-20l each having a housing 40 which includes an electro-mechanical ejection device and a reservoir 42 in communication with a fluid handling system 50, and (2) a substrate support 82 for positioning a substrate 80 below the ejection devices 30a-30c (see, e.g., col. 3, lines 57-63; col. 4, lines 48-50; and Figs. 1 and 4). Hayes et al. does not teach or suggest a purge station or any analogous station.

Burke et al. fail to makeup for the deficiencies of Hayes et al., as Burke et al. do not teach or suggest a purge station. Specifically, Burke et al. teach an apparatus for cleaning a printhead of a thermal inkjet cartridge that includes a service station having a wiper for wiping the printhead of a thermal inkjet cartridge (see e.g., abstract and Figs. 5-16). However, as noted above, neither a purge station nor any analogous structure is taught in Burke et al.

Accordingly, the cited references alone or in combination fail to teach or suggest a purge stations as claimed in the subject claims. As such, a *prima facie* case of obviousness cannot be made and the Applicants respectfully request that this rejection be withdrawn.

Claims 1-3 and 10-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Barth et al. in view of Burke et al.

The Applicants respectfully submit that Barth et al. is not a proper reference under 35 U.S.C. § 103(a) as Barth et al. and the subject application were, at the time the subject invention was made, subject to an obligation of assignment to the same entity. As stated in the MPEP at section 706.02(I)(1) *Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103*, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

For at least the reason that Barth et al. and the subject invention were subject to an obligation of assignment to the same entity at the time the invention was made and thus Barth et al. is not a proper

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reference under 35 U.S.C. 103 via 35 U.S.C. 102(c), the Applicants respectfully request that this rejection be withdrawn.

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CONCLUSION

In view of the remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078, reference no. 10990640-2.

Respectfully submitted,
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